

REMARKS

Claims 1-21 are all of the claims presently pending in the application. The claims have not been amended by this Response.

Applicant gratefully acknowledges the Examiner's indication that claims 9-13 and 19-21 are allowed. However, Applicant submits that all of claims 1-21 should be allowed.

Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by JP No. 09-46110 to Wataya Masafumi (hereinafter "JP '110"). Claims 1-7 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura (U.S. Patent No. 6,243,563) in view of JP '110.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a portable telephone set including a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals, a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit provided in a second housing for demodulating the radio signal from the switch (e.g., see Application at page 5, lines 16-25).

The claimed invention (e.g., as defined by exemplary claim 8) is directed to a portable telephone set including a radio circuit for demodulating a radio signal received by an antenna and transmitted via a cable, and a battery for supplying power to the radio circuit, wherein the battery and the radio circuit are interconnected by the cable, and wherein power from the battery is supplied via the cable to the radio circuit (e.g., see Application at page 8, lines 7-14).

The claimed invention, of exemplary claims 1 and 8, provides a portable telephone capable of efficient inter-housing transmission of radio signals (see Application at page 5, lines 12-15). Furthermore, the claimed invention provides a portable telephone set with reduced size and weight (see Application at page 5, lines 9-11).

II. THE REJECTIONS BASED ON PRIOR ART REFERENCES

A. Claim 8

The Examiner alleges that JP '110 teaches the claimed invention of claim 8. Applicant submits, however, that there are elements of the claimed invention, which are neither taught nor suggested by JP '110.

That is, JP '110 does not teach or suggest "*wherein power from the battery is supplied via the cable to the radio circuit*", as recited by claim 8.

The Examiner attempts to rely on Figure 1 and paragraph [0027] of JP '110 to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does JP '110 teach or suggest that power from the battery is supplied via the cable to the radio circuit. Indeed, JP '110 merely teaches transmitting power from a power supply section (9) through a coaxial cable (32) to a high frequency amplifier (7) (see JP '110 at Abstract).

That is, as best understood, the "radio circuit for demodulating the radio signal" in JP '110 is located in the main body 3 ("...and the amplified signal is fed to a receiver of the telephone set main body 3"). Thus, the configuration shown in JP '110 fails to satisfy the plain meaning of the claim language, since the battery (B) and the power supply circuit (23) are also located in the main body 3.

The Examiner previously relied upon by the receiver (21) of JP '110 to teach or suggest the radio circuit for demodulating the radio signal. However, in the Response to Arguments, the Examiner relies upon the amplifier (7) as teaching a radio circuit. Specifically, the Examiner alleges "the term "radio circuit" could be any electronic components, such that receiving amplifier (LNA), transmit amplifier, low pass filter, band pass filter, and etc. So anyone of the electronic components by itself or together constitute radio circuit. In other word, radio circuit by itself is a really broad term" (emphasis added by Applicant; see Office Action dated April 3, 2006 at page 2). The Examiner, however, is clearly incorrect.

Even assuming, *arguendo*, that the Examiner's above allegations are correct, and that the term "radio circuit" by itself is a "really broad term", Applicant submits that the JP '110 still fails to meet the plain meaning of the claimed invention.

Indeed, the claimed invention does not merely recite a "radio circuit". The claimed invention, e.g., of claim 8, clearly recites "a radio circuit for demodulating a radio signal

received by an antenna and transmitted via a cable". Therefore, the claimed invention does not recite the term "radio circuit" by itself, and it is erroneous for the Examiner to construe the meaning of the term "radio circuit" as such.

Applicant submits that the amplifier (7) of JP '110, which the Examiner analogizes to the radio circuit of the claim invention, fails to meet the plain meaning of the claimed invention. That is, nowhere does JP '110 teach or suggest that the amplifier demodulates a radio signal received by an antenna and transmitted via a cable.

Therefore, in JP '110, the battery (B) and the radio circuit are clearly provided in the same housing. Therefore, the battery (B) does not provide power to the receiver (21) through the coaxial cable (32).

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggested by JP '110. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. Claims 1-7 and 14-18

The Examiner alleges that JP '110 would have been combined with Nakamura to form the claimed invention of claims 1-7 and 14-18. Applicant submits, however, that JP '110 would not have been combined with Nakamura as alleged by the Examiner.

That is, neither JP '110, nor Nakamura, nor any combination thereof, teaches or suggests "*a switch provided in a first housing for selecting the radio signal determined in the detector to be the better receiving sensitivity one; and a radio circuit provided in a second housing for demodulating the radio signal from the switch*", as recited in claim 1, and similarly recited in claims 2-5.

Indeed, the Examiner concedes that "Nakamura doesn't expressly teach that how all the electronic elements have been distributed into housings and been interconnected by a cable" (see Office Action dated April 5, 2006, at page 4).

The Examiner alleges that JP '110 makes up the deficiencies of Nakamura. Specifically, the Examiner alleges that JP '110 teaches a switch provided in a first housing, a radio circuit provided in a second housing and a cable for connecting the switch and the radio circuit. The Examiner attempts to rely on Figure 1 of JP '110 to support his allegations.

Applicant submits, however, that JP '110 fails to make up the deficiencies of

Nakamura because JP '110 would not have been combined with Nakamura as alleged by the Examiner.

That is, section 2142 of the MPEP states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." (Emphasis added).

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has failed to provide any motivation for combining the teachings of Nakamura and JP '110. Indeed, the Examiner merely alleges that it would have been obvious to combine the teachings of Nakamura and JP '110 "such that the transmitter with which attenuation by transmission on the body of a transmitter of an input signal can be compensated via a cable" (see Office Action dated April 5, 2006, at page 4). The Examiner has merely provided a reason for providing a cable in the device of Nakamura.

However, the Examiner has provided no motivation or suggestion for combining the separate housings of JP '110 with the device of Nakamura. Indeed, there is no teaching or suggesting in JP '110 nor Nakamura, nor anywhere else for that matter, for providing the features of the Nakamura in two separate housings.

The Examiner appears to be alleging that the mere presence of the disclosure of a feature in JP '110 is sufficient to find that it would have been obvious to modify Nakamura based upon this disclosure.

However, the Examiner cannot merely gather a number of prior art references which each include some portion of the features recited in the claims and allege that the mere disclosure of the features in the combination of references is sufficient to allege obviousness of the claimed invention.

Rather, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (Emphasis added, M.P.E.P. § 2143.01).

Indeed, it is pointed out that the rejection currently of record fails to meet the initial burden of a *prima facie* rejection, as clearly stated by the evaluation guidelines in the M.P.E.P. It is pointed out that M.P.E.P. §2141.02 clearly states the following very basic evaluation guideline: "*In determining the differences between the prior art and the claims, the question*

under 35 U.S.C.103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" (emphasis in MPEP itself).

This guideline reflects the well established concept in patentability evaluation that a new invention may "merely" be a new and different combination of known elements.

Along these lines, Judge Rader wrote in the recent Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

*"In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envil. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention."*

Although the holding in that case left undisturbed, under the "clear error" standard of review, the conclusion of the District Court that the prior art references were properly combinable, it specifically explained that it declined to reverse this conclusion because "... the two references address precisely the same problem ..." (emphasis by Applicants).

This aspect of the *Ruiz* holding, in which precisely the same problem is being addressed by both references, is not present in Nakamura and JP '110, used in the prior art evaluation of the present Application.

Specifically, Nakamura is specifically directed to preventing breakage of structure elements due to a high power transmission radio signal (see column 2, lines 57-61 of Nakamura). In stark contrast, JP '110 is specifically directed to compensating for attenuation due to transmission of a reception signal (see Abstract of JP '110).

Therefore, Applicant respectfully submits that these references would not have been combined as alleged by the Examiner. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-21, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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